REMARKS/ARGUMENTS

Claims 1-26 were originally filed and are presently pending in the application.

In this amendment, Claims 1, 3, 6, 9, 14 and 17 have been amended.

Claims 27-29 have been added.

Claims 2, 4, 5, 7, 8, 10-13, 15, 16 and 18-26 remain unchanged.

In accordance with the new rules, all the claims are shown above, and the amended claims are shown in a redlined format. The amendment to the specification is made by replacing noted paragraph with the corresponding paragraphs set forth above. As set forth below, the amendments to the Claims are believed to place the Claims in condition for allowance. In view of the amendments, as discussed below, reconsideration of the Application and issuance of a Notice of Allowability are respectfully requested.

Amendments To The Specification

Applicants have amended the specification as noted above to correct typographical errors. These changes to the specification do not add new matter to the application.

The Wall Street Journal Article Is Not Prior Art

Applicants note that the Examiner relied upon an article published on November 20, 2003 in the online version of the Wall Street Journal (the WSJ Article). Although Applicants made this article of record in the filing of their information disclosure statement, the filing of an information disclosure statement does not amount to an admission that the reference provided is, in fact, prior art. See 48 Fed. Reg. 2696; *Abbott Laboratories, Inc. v. Baxter Pharmaceutical Products, Inc.*, 334 F.3d. 1274, 1279 (Fed. Cir. 2003).

As can be appreciated, the publication date of the WSJ Article is only five days prior to the filing date of the present application. The WSJ Article was published on a Thursday, and this application was filed the following Tuesday. Filed herewith is a declaration under Rule 1.131 of Ronald Uhlig, one of the named inventors in the application. As set forth in the declaration, the claimed invention was conceived prior to the publication date of the WSJ article, and the inventors were diligent from just prior to the publication date of the WSJ article and the filing date of their application (i.e., between November 19, 2004 and November 25, 2004). 37 C.F.R. §1.131; MPEP §715.07(a) ("Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application)."). As set froth in Dr. Uhlig's declaration, work on the application began in July 2003 and continued on into October 2003. By the end of October 2003, the application was nearly complete, and a conference call was held on or about November 6, 2003, between Mr. Uhlig, the undersigned patent attorney, and some of the other named inventors. As a result of that conference, revisions were made to the application, and a final draft of the application was transmitted to the inventors, along with the combined declaration and power of attorney on November 12, 2003 – eight days *before* the WSJ Article was published. (R. Uhlig Dec., ¶9) After a prodding e-mail on November 17, 2003, most of the inventors had signed and faxed the signed declaration to the undersigned attorney by Thursday, November 20, 2003 (the same day as the WSJ Article was published). (R. Uhlig Dec., ¶10) The last inventor signed the declaration on Friday, November 21, 2003 and faxed it to the undersigned attorney on Monday, November 24, 2003. (R. Uhlig Dec., ¶11) The application was then filed the next day – Tuesday, November 25, 2003.

From this timeline, it can be seen that the invention was conceived of (and in fact that application was finalized) *before* the WSJ Article was published. The application was then filed a mere five days (which included a weekend) after the WSJ Article was published. Hence, it can be seen that the invention was conceived of prior to the publication date of the WSJ Article, and the inventors were diligent in reducing the invention to practice (via filing of the application) in the critical period from just prior to the publication of the WSJ Article to the filing of the application. In view of this, it is respectfully submitted that the WSJ Article is not prior art under 35 U.S.C. 102. Withdrawal of the WSJ Article as a reference against the claimed invention is thus respectfully requested.

Brief Overview Of Applicants' invention

Briefly, Applicants' invention is directed to a remote (and, in the preferred embodiment, a portable) storage device which contains a user's profile, application settings and files currently being worked on and software used in conjunction with the storage device. When a user connects the storage device to a host computer, the user logs on to the computer. The computer's settings are updated to conform to the profile stored on the storage device, and the files resident on the storage device are copied to the host computer (Application FIG. 2A-B, blocks 316 and 320). The storage device also includes a list of applications expected to be found on the host computer. If any of these applications are missing, the user is so notified. (FIG. 2B, blocks 323-324). For the expected programs found on the host computer, the application settings are updated to correspond to the user's desired settings as stored on the storage media. At the end of the log-on process, the software, opens all files that were open at the end of the prior session. (Par. [0037], [[0039]). Hence, if a user finished a session with a file open, the software stores this data on the storage device, and, at the initiation of the next session, this file will be opened so that the user can continue work on the file.

At the end of the user's session, the user logs off from the host computer. As part of the log-off routine, all files that were copied to the host computer are copied back to the storage device and deleted from the host computer. (FIG. 2E). As noted in the specification at paragraph [0011], the data on the storage device can also be backed up on a server. During a session, the files are periodically backed up to the storage device. The user can also "check-out" files from a network to which the host computer is connected. If files are checked-out, the files are copied to the storage device and marked on the network system or host computer as being protected. When the user logs-off, to end a session, the user is given the option of updating the files on the network. If the files are to be updated, then the current file is copied from the storage device to the host computer or network. (Application, par. [0013], FIG. 2E, Blocks 375-376). When a user logs-on, the host computer's current profile settings are saved prior to instituting the user's profile settings. (FIG. 2A, block 310) Upon log-out, the host computer's original profile settings are reinstalled to return the host computer to the state it was in prior to initiation of the session. (FIG. 2E, block 380)

As set forth in the application, the storage device and associated software enable a user to work on different computers at different times and provides the user with the same computer interface at each computer. Further, because the files are maintained on the storage device, the user can work on a single document over several sessions and even at several different computers. Because the files are copied to the local computer during a session, the user will always know where to locate the files – they will be in the same "directory" or "folder" each time, and there is no need to worry about what drive letter or name might be assigned to the storage media. Further, because the files are deleted from the host computer at log-off, no confidential information will be left behind on the local computer.

Lastly, as set forth in Par. [0046], the software can be provided with an administrative function. The administrator can control access rights to the storage devices, create user profiles and verify user information (for example, should a user forget a password). Such administrative rights are beneficial, for example, in a school environment, wherein a student may use the storage device for only the school year, and at the beginning of the next school year, the administrator will assign the storage devices to a new set of students.

Claims 9-11 Are Not Anticipated By Ban.

The Examiner rejected Claims 9-11 under 35 U.S.C. §102(e) as being anticipated by Ban (Published App. No. 2004/0073787). Briefly, Ban is directed to a personal storage medium (PSM) on which is contained a user profile. As disclosed in Ban, the user profile contained on the PSM is used to update the profile contained on a local or host computer. In a safe environment (such as a workplace) this is accomplished by synchronizing or updating the profile on the host computer with the profile on the PSM. (See Ban, Par. [0069] and FIG. 1). In an "unsafe" environment (i.e., an internet café), the user profile is not copied to the host computer, and the user profile on the PSM is used to update the settings of the host computer. In either environment (safe or unsafe), once the user has logged on, the PSM is recognized as another disk drive on the host computer or a network node. (Ban, par. [0070] and FIG. 2). In Par. [0071], Ban states:

> "the first option is that in which a user profile, which is stored in a portable storage medium, is locally mirrored, typically to be used in a familiar and trusted environment. The second option is that in which *no mirroring of profiles is performed* and therefore logging on to the computer system is impossible without operationally connecting the portable storage medium to the computer system. *The second option is typically used in a foreign or unsafe environment. It should be noted that the second option is equivalent to preventing a copy of the user profile remaining available to the computer system after the portable storage medium and the computer system are operationally disconnected, by at least one of the computer system and the portable storage medium.*" (emphasis added)

Ban also provides for a validation certificate (without describing the certificate) to prevent logging on to the computer using the PSM in certain instances. Such instances are generally noted to be cases where a patron is paying for use of computer time for a specified time period, such as in a hotel. (See Ban, par. [0072])

Claim 9, as amended, is directed to the software for use with the storage device, and, in particular, now provides that the method carried out by the software includes determining if the computing device to which the external storage device is connected contains applications which are expected to be found on the computing device. If expected applications are not found (i.e., are not installed on the computing device), then the method provides for notifying the user of the fact that certain of the expected applications are missing. This is shown in FIG. 2B at blocks 323 and 324 and is described at paragraph [0035] on page 18 of the application. Hence, this amendment to Claim 9 does not add new matter.

Neither Ban nor any of the other references of record teach or suggest determining if expected applications are present on (or missing from) the computing device, and then notifying the user of such missing application(s). Thus, Claim 9 is believed to be allowable over Ban. Claims 10-11 depend from Claim 9 and are similarly believed to be allowable over Ban.

Claims 1, 2, 4, 6, 14, 17, 18 And 23-24 Are Not Made Obvious By Fischer Et Al.

The Examiner rejected Claims 1, 2, 4, 6, 14, 17, 18 and 23-24 under 35 U.S.C. §103 as being unpatentable over Fisher et al. (published app. no. 2004/0095382). Fisher is directed to a portable memory device which contains a user profile, and on which a user can carry files. Fisher provides that the portable memory device allows a user to work on a file at different computers. Fisher also discloses a "hibernation" feature which enables the user to work on the document over a series of user sessions.

With respect to Claim 1, the Examiner stated that "at the time the invention was made, it would have been well within the ordinary skill in the art to include applications that are previously used, in order to allow the user access to programs even if they are not installed on the host computer." Applicant respectfully traverses the Examiner's assertions. Initially, Applicants note that Claim 1 does not provide for a step of allowing access to programs which are not installed on the host computer, as set forth by the Examiner in the just quoted passage. Secondly, the Examiner has provided no evidence that, at the time of Applicants' invention, that the step described by the Examiner was "well within the ordinary skill in the art" and requests that the Examiner provide prior art references which supports the Examiner's assertion. MPEP §2144.03(C).

Claim 1 has been amended to provide that the storage device also contains "personalized application characteristics". Such application characteristics can include, for example, font setting, font size, font color, paragraph settings, page settings, tool bar settings, application "option" settings, etc. The method of Claim 1 has been amended to include the step of implementing the personalized application characteristics. While Fisher et al describe that a user can work on a file over several sessions, Fisher et al. do not teach or suggest the implementation of the user's personalized *application characteristics*. By updating the application characteristics, the user is given access not to a generic version of an application, but to the application as personalized by the user. Hence, as noted above, the program will include the user's selected font size, type, and color; the tool bars as modified or customized by the user; application macros, etc. This is simply not taught or suggested by Fisher or any of the other references of record, whether considered individually or in combination. Hence, Claim 1 is believed to be in condition for allowance.

Claims 1, 2, 4 and 6 all depend from Claim 1 and are hence believed to be allowable over Fisher for the reasons noted in conjunction with Claim 1. Applicants respectfully point out that Claim 6 provides that the personalized information setting includes "a list of applications found installed on the computing device to which the user has access". To further clarify this aspect of Claim 6, Claim 6 has been amended to provide that the method includes the steps of "comparing the list of applications found installed on the computing device to the list of applications expected to be found on the computing device and notifying the user of any expected applications which are not found on the computing device". This is disclosed, for example, in FIG. 2B, blocks 323-324. Fisher does not teach or suggest the comparison step nor the notification step. Hence, Claim 6 is believed to be allowable over Fisher independently of Claim 1.

Independent Claim 14 has been amended to remove the "means for opening" paragraph and replace it with a paragraph which provides for the administrative functions set forth in paragraph [0046] (page 26) of the specification. As amended, the program of Claim 14 includes

> "means for allowing administrative access to said storage device to enable an administrator to access, alter and/or erase data,

> including a user's personalized setting information and passwords, on the storage device. "

This is described at paragraph [0046] of the application and hence does not add new matter to the application. Fischer does not teach or suggest such administrative control of the storage device. Such administrative control is desirable, for example, in a work or school environment, where the storage devices belong to the company, school etc. and not the individual. The administrative control allows for the storage devices to be provided to a new user when a first user is no longer using the device (i.e., when a student graduates from the school, or at the end of a school year). The administrative control will also allow for oversight as to what the device is being used for. Such administrative control is not taught or suggested by Fisher. Hence, Claim 14 is believed to be allowable over Fisher. Claims 15-26 depend from Claim 14, and hence are also believed to be allowable over Fisher.

Claim 17 depends from independent Claim 14 and is thus believed to be allowable for the same reasons set forth above with respect to Claim 14. However, Applicants note that Claim 17 has been amended to change "loading" to "copying" such that Claim 17 provides for "means for copying said user's files from said external storage device to said computing device at the beginning of a user session" It is respectfully submitted, that although Fisher may inherently disclose "loading" of a file (which might be interpreted to be necessary to work on any computer file, inasmuch as it is necessary to "load" a file into the computer's memory to work on the file), Fisher et al. do not disclose the *copying* of the file to the host computer. Hence, Claim 17 is believed to be allowable over Fisher independently of Claim 14.

Claims 23 and 24 depend from independent Claim 14 and are believed to be allowable for the reasons noted above with respect to Claim 14. However, Applicants note that Claims 23 and 24 are directed to periodically saving files to the external storage device. The Examiner asserts that it is well known to periodically save the most recent preferences/changes. As examples, the Examiner refers to block 26 of Ban and the WSJ Article. Block 26 of Ban states "synchronize local copy." A careful reading of Ban discloses that what is being synchronized is the user profile stored on the local or host computer based on the profile from the portable storage medium. The WSJ Article discloses synchronizing of data, but does not disclose a periodic update of files. Further, as noted above, Applicants conceived of the claimed invention prior to the publication date of the WSJ article and were diligent in reducing the invention to practice (via filing of the instant application) from prior to the publication date of the WSJ article to the filing date of the application. Hence, the WSJ Article is not prior art against the instant application. Thus, Applicants respectfully assert that the Examiner has not shown that it is "well known in the art" to provide a roaming profile, as used by Applicants, with the ability to save files to an external storage device as set forth in Claims 23 and 24. In accordance with MPEP

§2144.03(c), Applicants respectfully request that the Examiner provide references which teach or suggest the invention of Claims 23 and 24.

Claims 3, 7, 8, 15 and 16 are not unpatentable over Fisher in view of the WSJ Article

Claim 3

Claim 3 depends from Claim 1 (via Claim 2) and is believed to be allowable for the reasons set forth in conjunction with Claim 1. Claim 3 is also believed to be allowable independently of Claim 1. Claim 3 provides that the method of Claim 1 includes the steps of copying files to the computing device and then later deleting the files from the computing device after they have been saved on the storage device. Claim 3 has been amended to clarify that the files are copied from the storage device to the computing device at the beginning of a user session, and then, at the end of the user session, the files are copied back to the storage device and then the files are deleted from the computing device. The Examiner states in Par. 4 of the Office Action that "Fisher et al. teaches storing the files on the storage device but is silent to deleting them from the computing device. However, it is obvious to do so to remove the users customized interface and other information specific to the users settings." From this statement, it appears that there may be some confusion as to Applicants' software and its method of operation. Applicants' method does not include the copying of profile information to the computing device. The computer and application settings are updated from the information stored on the storage device. What is being copies are the files on which the user will be working (i.e., word processing files, spreadsheet files, presentation files, etc.). As noted by the Examiner, Fisher is silent as to the deleting of such files from the computing device. In fact, Fisher is also silent as to the copying of the files to the computing device. As noted above, the WSJ Article is not prior art. Further, even if it were prior art, it does not teach or suggest the copying of files to the computing device at the beginning of a user session and then deleting them from the computing device after they have been copied back to the storage device at the end of a user session.

The Examiner noted that it would be obvious "to remove the users customized interface and other information specific to the users settings." However, as just noted, this is not what is being claimed. Further, the Examiner has not cited any references which in fact teach what the Examiner asserts (namely, deleting profile information from the computing device).[1]

[1] Applicants respectfully point out that Ban does not teach deleting profile information. In the instance where the host computer is an "unsafe" computer, Ban teaches using the profile information directly from the storage device, and explicitly teaches that the profile information is not to be copied to the "unsafe" host computer.

Hence, Applicants respectfully submit that the subject matter of Claim 3 is neither taught nor suggested by the cited references. Claim 3 is thus believed to be allowable independently of the allowability of Claim 1.

Claims 7 and 8

Claims 7 and 8 both depend directly from Claim 6, which in turn depends from Claim 1. Claims 7 and 8 are thus believed to be allowable for the reasons noted above in conjunction with Claims 6 and 1.

Claim 15

Claim 15 depends from independent Claim 14 and is believed to be allowable for the reasons noted above in conjunction with Claim 14.

Claim 16

Claim 16 depends from independent Claim 14 and is believed to be allowable for the reasons noted above in conjunction with Claim 14. Claim 16 provides that the software program includes "means for removing any of said user's files from said computing device at the end of a session." This is similar to what was set forth in Claim 3. As discussed above in conjunction with Claim 3, none of the cited references, whether considered individually or in combination, teach or suggest the deleting of the user's files from the computing device at the end of a user session. Claim 16 is thus believed to be allowable over the cited references independently of Claim 14.

Claims 5, 19-22 and 25-26 are not unpatentable over Fisher in view of Ban

Claim 5

Claim 5 depends directly from Claim 1. As discussed above, Claim 1 is allowable over Fisher, and Ban does not add to the teachings of Fisher to make obvious the subject matter of Claim 1. Hence, Claim 5 is believed to be allowable for the same reasons set forth above in conjunction with Claim 1.

Claims 19-22

Claims 19-22 depend from Claim 14 and are believed to be allowable for the reasons set forth above in conjunction with Claim 14. Claim 19 is directed to the ability for a user to "check out" a file and for noting on the computing device or network that the file has been "checked out". Claims 20-22 depend from 19 and further define the "check out" routine. The Examiner asserts:

> "Roaming profiles have means for marking files as checked out/protected since they are accessible by only the normal user who has the corresponding profile. However, roaming profiles include means for releasing the protected files since network users are able to save files to a common drive (shared) or area, when needed, as is known in the art.

In support of his rejection, the Examiner cites to the WSJ Article to note that it is "well known to select files to be stored on the external storage device." However, as noted above, the WSJ Article is not properly prior art with respect to the claims of this application. At page 8 of the office action, the Examiner states:

> "Further, as Ban et al. teaches using a profile on computer system where the user is known and that updated copies are stored on the external storage and the computing device itself (paragraphs [0067] and [0068]) it is clearly obvious that files associated with a stored (on the computer system) profile have means for being protected and released in order to provide security and sharability, as is conventional and well known in the art, while providing security, which is essential and a pressing concern in computing at the present time."

While Ban et al. do, as the Examiner notes, teach the copying of the profile to "safe" computers, Applicants respectfully submit that Ban et al. contain no teaching or suggestion relating to Applicants' "check out" routine. Hence, Applicants respectfully submit that the Examiner has no support for his rejection of Claims 19-22 other than the unsupported assertion that Applicants' "check out" routine "is known in the art" or is "obvious". The Examiner asserted that "roaming profiles include means for releasing the protected files since network users are able to save files to a common drive (shared) or area, when needed, as is known in the art." Applicants respectfully traverse the Examiner's assertion that it is well known in the art for roaming profiles to include means for releasing protected files, and request that the Examiner provide evidence to support his position. MPEP §2144.03.

Claims 25-26

Claims 25-26 depend from Claim 14 and are believed to be allowable for the reasons set forth above in conjunction with Claim 14.

Claim 12 is not unpatentable over Ban in view of the WSJ Article

Claim 12 depends directly from independent Claim 9, and is believed to be allowable for the reasons set forth above in conjunction with Claim 9. Further, as noted above, the WSJ Article is not properly prior art with respect to the claims of this application. Hence, for this additional reason, withdrawal of this rejection is respectfully requested.

Claim 13 is not unpatentable over Ban in view of Fisher

Claim 13 depends directly from independent Claim 9, and is believed to be allowable for the reasons set forth above in conjunction with Claim 9.

New Claims

New Claim 27 depends from Claim 9 and provides that "the personalized setting information stored on the external storage device also includes application characteristics" and that the method includes "implementing the personalized application characteristics". Such application characteristics can include, for example, font setting, font size, font color, paragraph settings, page settings, tool bar settings, application "option" settings, etc. The subject matter of new Claim 27 is shown in FIG. 2B, blocks 325-326 and described in paragraph [0035]. Hence, this does not add new matter to the application. While Ban and Fisher, for example, disclose updating user profiles on the computer, neither discloses updating application settings as set forth in new Claim 27. Claim 27 is thus believed to be allowable over Ban and Fisher, whether considered individually or in combination.

New Claim 28 depends from Claim 1 and provides that the method includes a step of copying files from the storage media to the computing device. Neither Ban nor Fisher teach or suggest this. Ban does not explicitly provide or even suggest that files are contained on his storage device. Fisher et al. do provide that files are stored on the device. However, Fisher et al. do not teach or suggest where the files are maintained during use of the device. They do not disclose is the files are maintained on the storage device or if they are copied to the host computer. Hence, without any such teaching or suggestion, Claim 28 is believed to be allowable over the references of record.

New Claim 29 depends from 1 and provides that, at the end of the user session, the user's data (files, application settings, computer settings, etc.) are all copied to a network computer (such as a server) in addition to the storage device itself. This will allow for backup of the information on the storage device to protect the data should the storage device itself ever be damaged. The ability to back up data to a network computer as well as the storage device at the end of the user session is described in paragraph [0011] of the application. Hence, the addition of new Claim 29 does not add new matter to the application. New Claim 29 depends from Claim 1, which, as discussed above is believed to be allowable. Hence, Claim 29 is also believed to be allowable. Further, none of the references are believed to teach or suggest that the user's data be backed up to a network computer in addition to the storage device itself, at the end of the user session.

In view of the foregoing, Claims 1-29 are believed to be in condition for allowance. A Notice of Allowability with respect to these claims is thus respectfully requested.

Respectfully Submitted,

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